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Edward L. Rapp

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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD L. RAPP, JAMIE TROY,
JEANNETTE DIDO, DOUGLAS MANN,
THOMAS COLLINS, KENVIN RABINOVITCH,
RALPH LEE, NEIL WILLCOCKS,
ROBERT BOUSHELL, RALPH JEROME,
TIAGO O. RODRIGUES, JOHN M. KAISER
and IVONNE E. NILL

Appeal 2009-002865
Application 10/615,249
Technology Center 1700

Oral Hearing Held: June 23, 2009

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, Administrative Patent Judges

ON BEHALF OF THE APPELLANTS:

RAYMOND R. MANDRA, Attorney-at-Law
Fitzpatrick, Cella, Harper & Scinto
300 Rockefeller Plaza
New York, New York 10112-3801

ALSO PRESENT:

ROBERT SCHROEDER, General Counsel, Technology,
Mars, Inc.

1 The above-entitled matter came on for hearing on Tuesday,
2 June 23, 2009, at 9:45 a.m. at the U.S. Patent and Trademark Office, 600
3 Dulany Street, Alexandria, Virginia, before Leanne M. Krivonak, Notary
4 Number 180129, Notary Public.

5 THE CLERK: Good morning. Calendar Number 51, Appeal
6 Number 2009-002865, Mr. Mandra.

7 JUDGE WARREN: Morning, Mr. Mandra.

8 MR. MANDRA: Morning.

9 JUDGE WARREN: Whom did you bring today?

10 MR. MANDRA: This is Robert Schroeder. He's General
11 Counsel, Technology, Mars, Incorporated, who is the party of interest in this
12 case.

13 JUDGE WARREN: As you know, sir, you have 20 minutes.
14 You may begin when ready.

15 MR. MANDRA: Yes.

16 Today we're going to be talking about energy bars and
17 application related energy bars, and if I could have the Bench's permission, I
18 would like to approach with an example of an energy bar that we're talking
19 about today.

20 JUDGE WARREN: As long as we don't have to consume it,
21 Counselor, we'll take a look at it.

22 Thank you very much.

23 MR. MANDRA: I actually purchased that this morning at the
24 PTO coffee shop.

25 JUDGE TIMM: So we may have it for lunch today.

26 MR. MANDRA: And they're quite satisfying.

1 At the moment we have pending claims, 1, 4, 6 through 8 and
2 10 through 24 that stand rejected. There are a number of independent
3 claims. I would like to focus, I think, on claim 1 and claims 21 and 22.

4 Of course, you have any questions about any other claims, I'd
5 be happy to answer them as we go through this. You know, the important
6 thing here is we're talking about an energy bar product. It's a good tasting
7 energy bar product, and what we mean by that, we've defined it, as having
8 high levels of protein, vitamins and minerals and most importantly, it's
9 relatively low in fat.

10 And specifically, I think you'll see each of the claims in the case
11 requires the bar to have 15 to 45 grams of carbohydrates, 1 to 4.5 grams of
12 vitamins and minerals, 8 to 40 grams of protein and 3 to 8 grams of fat, with
13 a specific calorie limitation of 150 to 300 and a certain moisture level of less
14 than 15 percent and that's for a 55 gram serving.

15 And then there are also listed in each of the claims various
16 carbohydrates and proteins and fat sources for making the bar.

17 All the product claims include a hedonic score that is a measure
18 of consumer acceptability. If you look at the specification, you'll see that
19 there was a 75 person panel used where they rated it on a scale of -- I believe
20 it was a 7 point scale from extremely like to dislike because the whole point
21 of this invention was to try to provide an energy bar having a high level of
22 protein and again, low fat that actually tested good for years.

23 MR. WARREN: Let's see why do they use this particular test
24 in your industry?

1 MR. MANDRA: You know, I'm not sure, Your Honor, as to
2 how widely it's used. It's certainly something that I think is used within the
3 company itself.

4 MR. WARREN: Well, is there an accepted standard or
5 accepted procedure for running the test?

6 MR. MANDRA: I think the procedure for running the test is
7 defined in the specification as to how it's run, as to the actual specifics, I'm
8 unsure.

9 But you'll note from the specification that there was a
10 comparison done using the same test against prior art energy bars.

11 They did first a screening test to determine what would be
12 considered to be the two, quote, best tasting energy bars that were on the
13 market, and then ran the full test against those two energy bars. I think there
14 was a POWERBAR and luna bar and determined a hedonic score for them
15 and then, of course, compared their inventive product against it.

16 JUDGE TIMM: In the screen test did you use the same
17 procedure with the 75 participants?

18 MR. MANDRA: The screening test did not use the 75
19 participants I'm quite -- my recollection serves me right, I think it was not as
20 extensive of -- though once those were selected as to be the comparators,
21 those did use the 75 person test.

22 JUDGE TIMM: I think in your specification you say that it
23 wasn't a side-by-side comparison.

24 How was the comparison run?

25 MR. MANDRA: If it wasn't a side-by-side comparison, then it
26 would have been simply a taste panel, right, and who was tasting and noting

1 somewhere between 1 to 7 when they're testing the product and that at
2 another time you'll do the 1 to 7 analysis.

3 JUDGE TIMM: With the same panel or a different panel?

4 MR. MANDRA: I believe it -- well, I thought it was the same,
5 but I'll defer on that. I would have to look more carefully at the spec. I
6 thought there were 75 participants that were used and I assumed that they
7 were all the same.

8 Now presently I would like to go to the rejections we have and I
9 think we understand what the rejections are although they vacillated a little
10 bit as we've gone through the appeal process and we believe that as we set
11 forth in our last reply brief that we understand what the rejections are and I
12 would just like to go over them quickly because in this case I think you're
13 aware of the record.

14 We had an office action that issued after our first brief was filed
15 with a re-open prosecution, but we chose to continue the appeal. And then
16 we had in the Examiner's Answer a new grounds of rejection issued against
17 us.

18 So at the present time we believe that the first rejection we
19 would like to deal with that the claims 1 through 4 and 10 through 24 are not
20 enabled under the first paragraph, 35 U.S.C. 112.

21 JUDGE SMITH: Excuse me, Counselor. Your description on
22 pages 4 to 5, your specifications indicates that the component comprises
23 vitamins and minerals.

24 Has the Examiner refuted that?

25 MR. MANDRA: The Examiner is not saying that we do not
26 have vitamins and minerals. I think that the position the Examiner is now

1 taking is that we have a limitation of 1 to 4.5 grams of vitamins and minerals
2 in the claim and is arguing that we did not enable that because originally the
3 claim was written as fortification components in which fortification
4 components included vitamins and minerals and several other possible
5 components.

6 I believe that's the position that's taken -- taken now.

7 But with respect to enablement I mean the question is going to
8 be is can a person of ordinary skill in the art make and use the invention
9 without undue experimentation and our whole specification is about making
10 good tasting energy bars using the techniques that are described in there and
11 we just don't understand how the Examiner could conclude that there would
12 be undue experimentation.

13 I mean, it clearly says 1 to 4.5 grams of fortification
14 components and the specs says one or more of and lists the vitamins,
15 minerals and anti-oxidants and so forth.

16 If you look at the examples in the specification, in that
17 situation, I believe there is somewhere on the order of about 1.9 grams to
18 about 2.5 grams of fortification blend that was used in the examples and
19 those blends, as I'm told by the inventors are primarily just mixtures of
20 vitamins and minerals.

21 So we just don't see where there could be any conclusion that
22 there be undue experimentation to use the range of 1 to 4.5 grams of
23 vitamins and minerals.

24 And that brings me to our next rejection, which is our
25 obviousness rejection. We believe at this point in time; again, like I said, it's
26 changed a little bit, that right now the Examiner is rejecting our claims 1

1 through 4, 6 through 8, 10 and 13 to 22 as obvious over Kelly in view of
2 Froseth.

3 (Telephone interruption.)

4 So as I just said, we believe the first rejection that we need to
5 deal with respect to the art is the Examiner's rejection of the claims 1
6 through 4, 6 through 8, 10 and 13 through 22 over Kelly in view of Froseth.

7 Now Kelly is directed to a breakfast bar and it has high protein
8 content and it's in a binder composition where the individual protein
9 particles and carbohydrate particles are substantially coated by fat.

10 And if you look at Kelly, I mean, you'll see in the preferred
11 binder, there's 23 percent of fat with a minimum of -- I'm sorry. With a
12 minimum of 33 percent fat to 85 percent weight fat, if I got that right.

13 And the preferred amount is actually 47 percent. So we've
14 submitted a declaration and the declaration of Edward Rapp is the first
15 named inventor on the case and he calculated based on the disclosure of
16 Kelly that the Kelly bar would have about 11 grams of fat in it.

17 You know, when you read through Kelly, I mean, it's really all
18 about -- it's about putting Wheat Chex into a cereal bar and they make a
19 binder composition that contains a significant amount of protein, but then
20 with a real significant amount of fat in order to make the protein taste bland
21 because they want you to taste the Wheat Chexes and they don't want you to
22 taste the protein, of course.

23 So the 11 grams of fat provided by Kelly is 25 percent higher
24 than our highest amount of fat that you can have, which is 8 grams in a 55
25 gram serving.

1 And if you use the preferable disclosure of Kelly which I
2 believe was the 47 percent in the binder, you'd actually have 15 and a half
3 grams of fat in the bar of Kelly.

4 I mean, we have said all along to the Examiner, it's known that
5 you can cover up taste using fat. I mean, that's pretty well known. The trick
6 here is to try to deliver a low fat product with a lot of protein that still tastes
7 good.

8 (Telephone interruption.)

9 Shall I proceed?

10 JUDGE SMITH: Yes, proceed.

11 MR. MANDRA: We also wanted to note that the Examiner
12 had indicated that Kelly's disclosure showed a technique of mixing in
13 vitamins and minerals at very low speeds and with low temperatures.

14 And we disagree with that. I think if you'll look at Kelly at
15 Column 5, lines 40 to 51 where it indicates that vitamins could be added to
16 the mix that it's simply saying that it's added to the binder. Now the binder
17 of Kelly -- now Kelly makes pretty clear that that binder is intensely mixed.

18 When it's processed, the Examiner went down to the Column
19 5 -- I believe lines 53 to 66 or so and argued that the teaching there of Kelly
20 that there be low heat and low shear mixing meant that the fortification
21 components would be added in that manner.

22 But in fact when you look at it clearly Kelly is disclosing at that
23 point in the reference that the cereal particles have to be carefully mixed in
24 with the binder composition as so not to destroy the cereal component.

25 I mean, they chopped the cereal up to a certain size and Kelly's
26 worried about the cereal becoming ground to a fine dust.

1 So we just don't see where Kelly disclosures, what the
2 Examiner is saying about the fortification components as binding vitamins
3 and minerals and we certainly continue to take the position that Kelly is all
4 about delivering a large amount of protein with large of amounts of fat to
5 mask the protein flavors.

6 We also believe that Froseth which is the other reference relied
7 upon, at least in the main rejection, does not overcome the teaching of Kelly.

8 Froseth is also a breakfast bar and it attempts to mimic the
9 traditional level of a single serving of cereal with milk in a bar. So really
10 what it is, it's two layers of Rice Krispies and with a milk filling, a solid milk
11 filling in a binder.

12 But the specification of Froseth or the pattern of Froseth makes
13 clear it's 16 grams of protein -- it chooses to deliver, oh, to six grams and
14 that can be found, I think in Column 1, lines 60 to 61, and Column 11, lines
15 49 to 52.

16 So Froseth -- it's our position -- does not overcome the
17 problems that Kelly has, which Kelly only teaches that you can administer
18 large amounts of protein that taste good with large amounts of fat.

19 Froseth provides some guidance on delivering vitamins and
20 minerals when they are susceptible to heat and temperature, but it really -- it
21 doesn't really focus on that. It mentions it, but it also happens to mention
22 that you can add such components any time in the process.

23 So then again, you know, it's been our position that Froseth
24 would not have directed someone skilled in the art to use the technique of
25 gently adding in the vitamins and the minerals into our composition and
26 even if it were when we've calculated the actual content of vitamins in

1 Froseth, I think you'll see in Mr. Rapp's first declaration, that he did the
2 calculation and it came out to about .66 grams of fortification components
3 would be in the Froseth breakfast bar, and that's about 44 percent below our
4 minimum requirement of 1 gram of fortification required -- components.

5 Again, the big thing with Froseth is it doesn't over come the
6 problem that's a low -- relatively low amount of protein. It's not dealing
7 with the same problem we have which is delivering larger amounts of
8 protein and keeping the energy bar tasting good.

9 So in short with respect to that rejection, we just don't think that
10 the Froseth -- that Froseth overcomes the deficiencies of Kelly and we don't
11 see how the determination of obviousness is reached with respect to that
12 rejection.

13 Now there is a rejection also combined with Rombauer. Here's
14 where we're a little bit confused because originally all the rejections, as we
15 entered the appeal, were based on Froseth. I'm sorry, based on Kelly in view
16 of Froseth and further in review of Rombauer.

17 The Examiner made new grounds of rejection and indicated that
18 she no longer was going to apply Rombauer to certain of the claims and we
19 were uncertain exactly which claims those were, whether it was 1 through 10
20 or all of them, except 11 and 12. But what's clear is she is still asserting that
21 rejection with Rombauer against claim 11 and 12.

22 And claim 11, which is a dependent claim requires a fat
23 carbohydrate matrix which is gently folded into the energy bar matrix and
24 that energy bar matrix includes one or two solid components and
25 carbs -- and a carbohydrate based syrup.

1 We just don't see how Rombauer discloses first even the high
2 protein because it's only 4.6 grams of protein in a 55-gram serving and it just
3 doesn't seem to be really relevant to us since it's a cookie. It's never close to
4 any energy bar. I mean, there's absolutely no fortification components.

5 Then I would like to go back to yet another rejection that we
6 believe is currently of record and that is to -- with respect to our protein
7 components.

8 Let me find my spot here. The Examiner also rejects -- I think
9 it's claims 23 and 24. If you look at -- and they're dependent claims off of
10 Claim 22. Twenty-two is directed to one of the other techniques that use to
11 make the energy bar taste good which is an engineered protein powder.

12 It was found that if you kept the protein powder, at least a
13 certain percentage of it above a certain size -- I think it's 35 microns in the
14 claim, that you actually got a very good tasting product or you approve the
15 hedonic score, as we described it.

16 Claims 23 and 24 sort of have more specifics regarding that.
17 The Examiner has indicated Avera reference fills in the deficiencies and we
18 disagree.

19 Avena is directed to a peanut butter. It is not directed to protein
20 powders. We just don't see how it overcomes -- you know, how it is even is
21 relevant for our claim limitation and the interesting thing is if you look at
22 Kelly which is being combined, Kelly actually discloses or teaches away
23 from the use of peanut butter protein because the whole point of Kelly was to
24 make a very bland binder composition; and thus, Kelly suggested that peanut
25 butter was not something that would want to be used in Kelly so we don't

1 even see how it's combinable with Avena. But again, we don't think Avena
2 discloses our engineered protein powder.

3 And then I would also like to touch on the fact that we
4 had -- we have here indicia of non-obvious that has been submitted through
5 the declaration. There has been a long-felt need that energy bars have been
6 around for more than 20 years when this case was filed.

7 Most energy bars did not taste very good. It was always a
8 problem. People felt that they were stuck with that problem. Mr. Ramp, I
9 think, indicated in his first declaration that he spent some five years working
10 on the energy bar product. We think that shows it's not just a simple obvious
11 to try type situation where you simply manipulate some ingredients. There
12 was a significant amount of work that was put into this and on top of that,
13 we also submitted evidence of commercial success from, I believe, the first
14 two bars and the one you have in front of you were introduced in 2003.

15 So somewhere like September of 2005 those two bars had
16 become the number one and number two fastest selling energy bars on the
17 market and that's after the POWERBAR®, for instance, had been on the
18 market for some 20 years.

19 JUDGE WARREN: Now which declaration is that in, sir?

20 MR. MANDRA: Sir?

21 JUDGE WARREN: Which declaration is that --

22 MR. MANDRA: It should be. I think it's referred to in both,
23 but mostly in the second declaration.

24 Let me double-check that for you.

25 I think it states in the second declaration starting at paragraph
26 12 and moving through to about paragraph 16, there's a discussion of the

1 commercial success with the fact that there was a big sales velocity to
2 measure how well it was selling.

3 Okay. And sales velocity essentially -- it measures how quickly
4 a product moves off the shelf and again, by mid-2005 or September of 2005,
5 these energy bars were in the number one and number two position.

6 We also noted that in 2004 that there had been 25 million
7 dollars spent on introducing the energy bars in marketing in 2005 that had
8 been reduced to four million and compare that to 2005 with POWERBAR®
9 where there 15 million dollars was spent on advertising.

10 With respect to a nexus, I mean I think you'll see from the
11 declarations that Mr. Ramp submitted that there were at least six awards
12 given to various energy bars that emanate from this invention and I believe
13 there's at least one letter in there from Health Magazine awarding the
14 energy bar of the year award in 2006.

15 So we think there is a nexus. We clearly think there is
16 commercial success and we believe even if the Board were to consider a
17 prima facie case of obviousness had been made out by the Examiner, which
18 we don't think has been made out, that we would have overcome that prima
19 facie case and that the claims, as they currently stand, should be considered
20 patent able.

21 JUDGE WARREN: Any further questions?

22 JUDGE SMITH: No questions.

23 JUDGE TIMM: No questions.

24 JUDGE WARREN: Counselor, if you'll retrieve your bar.

25 Thank you very much. We're off the record.

1 Whereupon, at approximately 10:00 a.m. the proceedings were
2 concluded.